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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,500	12/28/2000	Marc Epstein	300/1	6952

7590 03/29/2004
KAPLAN & GILMAN, L.L.P.
900 Route 9 North
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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/29/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/750,500

Applicant(s)

EPSTEIN ET AL.

Examiner

Hussein A El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application filed on Dec. 28, 2000. Claims 1-31 are pending examination.

Specification

2. The abstract is objected because the abstract does not disclose a concise description of the invention.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "110-140" and "206-211" have been used to designate

client forest; reference characters "104-108" have been used to designate clients; reference characters "221-226" and "231-236" have been used to designate trust links. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "122-146" are not defined in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

5. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim 16 is dependent on claim 11 and claim 14 is an independent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 recites the limitation "them" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 11, 14-19, 22, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al., U.S. Patent No. 6,249,836 (referred to hereafter as Downs).

As to claim 1, Downs teaches a method of providing services from a service provider to a plurality of independent entities, the method comprising:

facilitating, on a first set of one or more servers of said service provider, a first set of services that require said first set of one or more servers to trust said independent entities (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5);

facilitating, on a second set of one or more servers of said service provider, a second set of services that require said independent entities to trust said second set of one or more servers (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5, trust s achieved between the server and the client by allocating separate resources to distinct clients, client requests resources and servers allocate requested resources to clients); and

providing said first and second set of services to said independent entities (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 2, Downs teaches the method of claim 1 wherein a trust is established so that said first set of servers' trusts said second set of servers.

As to claim 3, Downs teaches the method of claim 2 wherein said first set of servers provides data services and wherein said second set of services provides management and configuration services (see col. 5 lines 18-37).

As to claim 4, Downs teaches the method of claim 3 wherein each of said independent entities is organized as a single forest (see col. 3 lines 10-30).

As to claim 5, Downs teaches the method of claims 3 or 4 wherein each of said entities is organized as a single domain (see col. col. 4 lines 59-col. 5 lines 5).

As to claim 6, Downs teaches the method of claim 3 wherein at least one of said independent entities is embodied as a forest of computers that spans multiple customer sites (see col. 4 lines 59-col. 5 lines 27).

As to claim 7, Downs teaches the method of claim 1 wherein said first set of services comprises at least one of the following: virus protection services, remote access, backup, software sharing, and telephony services, and wherein said second set of services comprises at least one of the following: security, password management, software update, software distribution, access control (see col. 4 lines 32-45 and col. 5 lines 7-17).

As to claim 8, Downs teaches a system for providing computer services to a plurality of remotely located computers, the network comprising: a service forest for providing data services to said remotely located computers; a management and configuration forest for providing management and configuration services to said remotely located computers; said management and configuration forest and said service forest being separate from each other (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 11, Downs teaches a network of computers comprising a service forest that trusts and provides services to a plurality of independent remotely located user computers, wherein the user computers trust and are managed and configured by a management forest of computers, and wherein the service forest trusts the management forest (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 14, Downs teaches a computer service center comprising plural computers that implement services to numerous remotely located computers, and wherein services that require said remotely located computers to trust said service

center are separate from computers implementing services requiring said service center to trust said remotely located computers, thereby avoiding any two way trusts (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 15, Downs teaches the service center of claim 14 wherein said remotely located computers are arranged into groups, each group communicating on a local area network and being associated with an independent entity (see col. 4 lines 59-col. 5 lines 5).

As to claim 16, Downs teaches the computer service center of claim 11 wherein computers in the service forest communicate with a telephone network (see col. 4 lines 32-40).

As to claim 17, Downs teaches the computer service center of claim 16 wherein computers in the service forest communicate with the data network (see col. 4 lines 32-40).

As to claim 18, Downs teaches the computer service center of claim 16 wherein computers in the service forest provide data backup services for said remotely located user computers (see col. 4 lines 59-col. 5 lines 5).

As to claim 19, Downs teaches a method of providing computer services to plural remote customers comprising the steps of: classifying services to be provided to such customers as either services requiring customers to trust a service provider, or services requiring the service provider to trust said customer; and in response to said step of

classifying, determining from what computer or group of computers to provide said services (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 22, Downs teaches a method of providing services to a plurality of serviced entities from a service provider, the method comprising: defining a one way relationship; separating a first type of services wherein said relationship runs from the service provider to the serviced entity from a second type of services wherein the relationship runs from the serviced entity to the service provider, and separately implementing said first and second types of services (see col. 3 lines 56-col. 4 lines 17, col. 4 lines 59-col. 5 lines 5).

As to claim 27, Downs teaches apparatus for providing services to plural entities, said apparatus comprising: plural devices to be serviced; a first set of servers for providing a first set of services to said devices, said first set of servers having a one way predetermined relationship with said devices to be serviced; a second set of servers for providing a second set of services to said devices, said devices having said one way relationship with said second set of services.

As to claim 29, Downs teaches apparatus of claim 28 wherein said devices are customer computers, and wherein said service provider is a remote IT services provider (see col. 4 lines 32-45 and col. 5 lines 7-17).

8. Claims 9-10, 12-13, 20-21, 23-26, 28 and 30-31 do not teach or define any additional limitation over claims 1-8, 11, 14-19, 22, 27 and 29 and therefore are rejected for similar reasons.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- System And Method For Regulating A Network Service Provider's Ability To Host Distributed Applications In A Distributed Processing Environment by Mohammed et al., U.S. Patent No. 6,374,357.
- Method And Apparatus For Allocating Tasks To Remote Networked Processors by Downs et al., U.S. Patent No. 6,112,243.

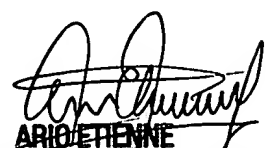
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

March 15, 2004


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